UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

V.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/189,334	11/09/98	POELKER D	6010-5989

IM62/0616

HOWELL & HAFERKAMP
7733 FORSYTH BOULEVARD
SUITE 1400
ST. LOUIS MO 63105

EXAMINER	
TUCKER, P	
ART UNIT	**PAPER NUMBER**
1721	4

DATE MAILED: 06/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)	
189334	POELKER ET AL.	
Examiner	Group Art Unit	
P. TUCKER	1721	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 – 38 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 – 38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Objections

1. Claim 38 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 38 fails to further limit parent claim 36.

Claim Rejections - 35 USC § 112

2. Claims 36 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "the imidazoline corrosion inhibitor" in claims 36, 38 or parent claim 17.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 14, 15, 17-20, 29, 30, 32 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fischer et al. (3682249).

Fischer teaches an emulsion which comprises a polymeric crystal modifier and wax dispersant, which is used to inhibit wax deposition. Fischer teaches that the emulsion may be water external (column 6, lines 49-54), and can contain corrosion inhibitors and bactericides (column 10, lines 23-26). The present invention is thus anticipated by Fischer.

It is not clear from Fischer that the composition has the same density and viscosity requirements as in the present claims. To the extent that Fischer may differ from the present invention, the optimization of the density and viscosity of the composition in order to achieve

optimal wax deposition inhibition, would be an obvious design choice to one of ordinary skill in the art.

6. Claims 1-8, 14, 15, 17-23, 29, 30, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer at al. (3682249) in view of McClaflin (4668408).

Fischer is taught in the previous paragraph. Fischer differs from the present invention in that the use of ethoxylated surfactants is not disclosed. McClaflin teaches the use of oil in water emulsions which comprise an ethoxylated alkyl phenol, a bactericide and corrosion inhibitor in the inhibition of wax deposition from a petroleum fluid. It would be obvious to one of ordinary skill in the art to use the ethoxylated alkyl phenol of McClaflin in the emulsion of Fischer, since the courts have held that the use of the combination of materials for the same purpose that they are taught as being individually useful in the prior art is not patentable (In re Kerkhoven 205 USPQ 1069, In re Pinten 173 USPQ 801, In re Crockett 126 USPQ 186).

7. Claims 1, 9-13, 16, 17, 24-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of McClaflin as applied to claim 1-8, 14, 15, 17-23, 29, 30 and 33 above, and further in view of Karydas (4997580).

Fischer in view of McClaflin is taught in the previous paragraph. Fischer differs from the present invention in that the specific use of an olefin-maleic anhydride copolymer is not disclosed. Karydas teaches that olefin-maleic anhydride and ethylene-vinyl acetate are commonly used as

equivalent crystal modifiers in wax inhibitor compositions. It would be obvious to one of ordinary skill in the art to utilize olefin-maleic anhydride copolymer instead of the ethylene-vinyl acetate copolymer of Fischer, given the teaching of Karydas that such copolymers are used as equivalent crystal modifiers in wax inhibition compositions.

8. Claims 17 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (3682249) in view of French (5027901).

Fischer teaches an emulsion which comprises a polymeric crystal modifier and wax dispersant, which is used to inhibit wax deposition in oil recovery. Fischer teaches that the emulsion may be water external (column 6, lines 49-54), and can contain corrosion inhibitors and bactericides (column 10, lines 23-26). Fischer differs from the present invention in that the specific use of imidazoline corrosion inhibitors is not disclosed. French teaches that imidazolines within the scope of the present invention may be used as corrosion inhibitors in oil recovery. It would be obvious to one of ordinary skill in the art to utilize known corrosion inhibitors, such as the imidazolines of French, in the oil recovery process of Fischer, given the teaching of Fischer that corrosion inhibitors are useful therein.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 5858927. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same aqueous external crystal modifier dispersion and method of utilizing said dispersion, thus rendering each set of claims obvious over one another.

11. Applicants arguments have been considered but are not deemed persuasive. . Applicants arguments state that claim 1 has been amended to incorporate that the water content is at least 25%, when no such amendment has been made. Even if such amendment has been made, the Fischer reference teaches that the water may be at a level of 10-90% volume (column 10, lines 9-16). The micellar dispersion clearly reads upon the composition of the present invention, since applicants intended use as an additive cannot distinguish over the prior art. Although Fischer

does not specifically teach the viscosities of the dispersions, it is taught that the viscosity of the dispersion may be adjusted by addition of hydrocarbon (column 10, lines 17-26). Applicant has not shown that the viscosities of the Fischer patent are so far outside the scope of those of the present invention as to render them nonanticipating or nonobvious. Applicants arguments with regard to the method of claim 17 is noted, however example 6 of Fischer clearly teaches the use of the dispersion as an additive to a petroleum reservoir. Applicant has further argued that the claims have been amended to include the limitation of the crystal modifier being at a level of at least 10%, when no such amendment has been made.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Sharon Gibson may be contacted at 703-308-4552. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-305-5408. The **after final** fax no. Is 703-305-3599.

PCT-1839
June 11, 1999

PHILIP C. TUCKER
ART UNIT 1721